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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/209,454	12/11/98	TANAKA	H 88125/ASAHIN

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TM02/0910

EXAMINER

LASTRA, D

ART UNIT

PAPER NUMBER

2162

DATE MAILED:

09/10/01 //

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/209,454

Applicant(s)

TANAKA ET AL.

Examiner

DANIEL LASTRA

Art Unit

2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

1. Claims 1-14 have been examined.

Drawings

2. The drawings are objected to because in figure 9, "maintehance should read "maintenance"; "finace" should read "finance" and "commercial" should read "commercial". Correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schlueter, Jr. et al (US 5,974,124) in view of Walker et al (U.S. 5,794,207).

As per claim 1, Schlueter et al teach:

"a communication network" (see column 4, lines 19-31);

"a plurality of first, second, and third information processing apparatuses connected to each other, through the communication network, each of the first, second, and third information processing apparatuses having calculation processing means, storage means, and transmitting/receiving means" (see figure 1 and summary of the invention).

Schlueter et al do not expressly show, "each of the first information processing apparatuses being located at a respective supplier of contact lenses and contact lens articles, each of the second information processing apparatuses being accessible to at least one contact lens user, and each of the third information processing apparatuses being located at respective ophthalmic examination departments". However, the collecting of medical information would be performed the same whether the information processing apparatus (see figure 1) is located in a family doctor's office or in a ophthalmologist's office. Further, lines 18-28 of column 2 and lines 58-67 of column 4 show that medical readings are taken in practitioners' offices, laboratories or directly by the users using portable devices. Thus, having the computer system in a doctor's office or in a contact lens seller or in the user's home, would not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the computer system shown in figure 1 would be located in a contact lens seller, an ophthalmologist office or in the user's home and that the location would not affect how the data would be transmitted.

Schlueter et al teach transmitting/receiving of medical information, such as heart rate, blood pressure, weight, body fat, etc, from primary computer 100 to any remote computer 50 connected to the network (see column 5, lines 25-67). The remote computer 50 is programmed to automatically access the primary computer 100 and transmit the data to the primary computer or receive data from the primary computer

(see column 4, lines 1-18 and column 6, lines 6-20). Schlueter et al also teach of medical readings taken in the medical practitioners' offices and laboratories that are uploaded to a centralized database via a common network or the Internet. If the Internet is used, adequate security precautions are taken to prevent unauthorized access to the information (see column 2, lines 38-44). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that to transmit data via the Internet, the Schlueter et al system would register its users and assign them password as this is a well known method to control access to customer data in the Internet.

Schlueter et al do not expressly show, "means for transferring at least one of a registration number, an identification of an ophthalmology examination department, a contact lens price, contact lens care articles price and a deadline for price payment from the respective first information processing apparatus to the second information processing apparatuses and means for transferring at least one of a registration number, name, age, sex and a password from the respective first information processing apparatus to the third information processing apparatuses and the transmitting/receiving means of the third information processing apparatuses includes means for transferring at least one of a registration number, name, age, sex, a selling date, contact lens information and eyeball diagnosis information from the respective third information processing apparatus only to the first information processing apparatuses." However, the transferring of information from one processing apparatus to another processing apparatus would be performed regardless of the type or kind of

data being processed. Thus, this descriptive material would not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). It would have been obvious to a person of ordinary skill in the art at the time the invention was made, to collect from a customer different types of diagnosis data and to transmit or receive diagnosis data from one processing apparatus to another. The subjective interpretation of the data does not patentably distinguish the claimed invention.

Further, the claim that the data is transmitted from the third processing apparatuses only to the first processing apparatuses would not patentably distinguish the claimed invention from the prior art. Schlueter et al teach a system where medical diagnosis data is transmitted and/or received from a primary computer 100 to remote computers 50. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that whether the Schlueter et al system would choose to transmit data only from a remote computer located in an ophthalmologic department to the primary computer located in a contact lens seller would be a business decision that would not affect how the step of transmitting the data is performed.

Schlueter et al fail to teach, "the transmitting/receiving means of each of the second information processing apparatuses include means for transferring an application for contract from each of the second information processing apparatuses to each of the first information processing apparatuses". However, Walker et al teach the

transmission of electronic contracts via a network, such as the Internet (see column 4, lines 13-20). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Schlueter et al system would transfer an application for a contract as taught by Walker et al. The contract would allow to legally bind customers to the Schlueter et al services.

As per claim 2, Schlueter et al do not explicitly teach, "wherein each of the information processing apparatuses includes one of a cathode ray tube and a liquid crystal display." However, this feature is deemed to be inherent to the Schlueter et al system as lines 1-31 of column 4 show that the system is entering data to the primary computer and if the primary or remote computer does not have a monitor where the user could see the input data, the system would be useless.

As per claim 3, Schlueter et al teach:

"wherein each of the information processing apparatuses includes one of a key board, a scanner, a mouse, and a bar code reader." (see figure 1). Official notice is taken that it is old and well known in the computer art the input devices like keyboards, and scanners.

As per claim 4, Schlueter et al do not explicitly teach, "wherein the storing means comprises a read-only memory and a random access memory. However, this feature is deemed to be inherent to the Schlueter et al system as the system is using computers to transmit data, and it is well known in the computer art that computers have read-only and ram memories.

As per claim 5, Schlueter et al teach, "wherein the transmitting/receiving means is a modem." (see column 6, lines 6-19);

Claims 6-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schlueter, Jr. et al (US 5,974,124) in view of Fajkowski (U.S. 5,905,246).

As per claim 6, Schlueter et al teach:

"a network" (see column 6, lines 6-20);

Schlueter et al do not expressly teach, "a plurality of processing apparatuses connected through the communication network, and divided into a first group and a second group, the first group comprising information processing apparatuses installed in facilities of contact lens sellers, the second group comprising information processing apparatuses installed in ophthalmology examining departments and storing data including at least one of name, age sex, date of diagnosis, eyeball diagnosis of a contact lens user, contact lens information, and contact lens selling date, obtained from diagnosis of the contact lens user in the ophthalmology examining department where the respective information processing apparatus included in the second group is installed, and transmitting the data through the communication network to the information processing apparatuses included in the first group". However, Schlueter et al teach of primary and remote computers connected through a communication network, that transmit and receive medical diagnosis data, such as heart rate, blood pressure, weight, body fat, etc. (see column 5, lines 40-67). The primary and/or remote computers could be located in the medical practitioner's office, in a store or in the user's home (see column 4, lines 1-18).

Schlueter et al do not expressly teach that the primary computer 100 is installed in facilities of contact lens sellers and that remote computer 50 is installed in ophthalmology examining departments and that the storing data includes at least one of name, age sex, date of diagnosis, eyeball diagnosis of a contact lens user, contact lens information, and contact lens selling date, obtained from diagnosis of the contact lens user in the ophthalmology examining department where the respective information processing apparatus included in the second group is installed, and transmitting the data through the communication network to the information processing apparatuses included in the first group. However, the transmitting steps would be performed the same regardless of the data and the location of the information processing apparatuses. Thus, this descriptive material would not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made, to transmit from one computer to another any type of data because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention. In other words, although the Schlueter et al system transmit diagnosis data such as heart rate and blood pressure and the claimed invention transmits other type of data such as date of diagnosis, name, sex, etc, these difference would not patentably distinguish the claimed invention from the prior art.

Schlueter et al teach, "a portable recording media, the plurality of information processing apparatuses having at least one of means for writing data in the portable recording media, means for reading data from the portable recording media, calculation processing means, storing means and transmitting/receiving means" (see figure 1, item 20 and 22 and column 4, lines 58-67);

Schlueter et al fail to teach, "the information processing apparatuses included in the first group processing and controlling the data, determining a registration number based on the data, recording at least one of the data and the registration number in only one of the portable recording media for a respective contact lens user, the medium having a password for the respective contact lens user. However, Fajkowski teaches a portable device where a registration number and a password is used to identify the user for the purpose of compiling marketing data in a point of sale location (see column 8, lines 32-62). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Schlueter et al system would include a registration number and password to access the data in its portable device, as taught by Fajkowski. The use of security precautions such as registration names and passwords to prevent unauthorized access to data would be an obvious feature to implement in the Schlueter et al system, as taught by Fajkowski. Neither Schlueter et al nor Fajkowski teach that the portable device is used by a contact lens users but it would be obvious to a person of ordinary skill in the art that the portable device would be used by anybody who wants to store data electronically and download or upload the data to another periphery device.

Schlueter et al fail to teach, "determining an exchange time for contact lens based on date of diagnosis, the contact lens selling date, and kind of contact lens, at least the exchange time for the contact lens being supplied to a contact lens user upon supplying of a contact lens." However, it was known at the time of the application that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example, simply automating the step of determining when the contact lens needs to be replaced would yield no enhancement other than the known advantage of increased speed. The end result would be the same when compared to the manual method.

As per claim 7, Schlueter et al do not teach, "wherein only the information processing apparatuses included in the second group have means of correcting the eyeball diagnosis information." However, if the processing apparatus is installed in a department of ophthalmology, it would have been obvious to a person of ordinary skill in the art at the time the application was made to know that the eyeball diagnosis could be changed because the department of ophthalmology would be the one making the eye's diagnosis in the first place.

As per claim 8, Schlueter et al do not expressly teach, "wherein the contact lens user can write information in the portable recording media." However, Schlueter, Jr. et al teach that patients can take their own readings using their own portable devices (see column 4, lines 58-67). It would have been obvious to a person of ordinary skill in the art

at the time the invention was made, to know that the same portable recording medium would be used by a contact lens user to record contact lens information.

As per claim 9, Schlueter et al do not teach "wherein each of the portable recording media has a respective password." However, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a password to the Schlueter et al portable device for added security. Because the Schlueter et al portable device is recording confidential medical information, adding an access code or password would be a useful and obvious feature to implement.

As per claim 10, Schlueter et al fail to teach, "wherein the plurality of information processing apparatuses can read data from all of the portable recording media and write the data in all of the portable recording media". However, Fajkowski teaches a system where peripheral devices could read and write data into portable recording media in a point of sale system (see abstract and summary of the invention). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Schlueter et al would include interfaces that would allow the peripherals devices, such as computers, to read and write data into portable devices, as taught by Fajkowski. This feature would allow the Schlueter et al's portable devices to be used in a point of sale environment, as taught by Fajkowski.

As per claim 11, Schlueter et al do not teach, "wherein each of the information processing apparatuses includes one of cathode ray tube and the liquid crystal display." However, this feature is deemed to be inherent to the Schlueter et al system as lines 1-31 of column 4 show that system is inputting data to the primary computer and if the

primary or remote computer does not have a monitor where the user could see the input data, the system would be useless.

As per claim 12, Schlueter et al fail to teach, "wherein each of the information processing apparatuses includes one of a keyboard, a scanner, a mouse, and a bar code reader." However, Fajkowski teaches a portable recording device used in a point of sale system that includes a keyboard, a scanner, a mouse and bar code reader (see abstract). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to include the feature of reading and writing data into a portable device using a scanner and bar code reader to Schlueter et al, as taught by Fajkowski. This feature would help the Schlueter et al system to be implemented in a point of sale environment.

As per claim 13, Schlueter et al do not explicitly teach, "wherein the storing means comprises a read-only memory and a random access memory. However, this feature is deemed to be inherent to the Schlueter et al system as the system is using computers to transmit data, and it is well known in the computer art that computers have read-only and ram memories.

As per claim 14, Schlueter et al teach, "wherein the transmitting/receiving means is a modem." (see column 6, lines 6-19).

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Kimura teaches a method of manufacturing spectacles by obtaining accurate frame shape information without performing a frame shape measurement in the spectacle store.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 703-306-5933. The examiner can normally be reached on 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W STAMBER can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-6165 for regular communications and 703-308-6306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

D.L.

Daniel Lastra
August 26, 2001

Stephen Gravini for GWS

STEPHEN GRAVINI
PRIMARY EXAMINER